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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,957	12/14/2001	Gary M. Rapps	CM02023K	7541
22917	7590	03/08/2004	EXAMINER	
			TRAN, SINH N	
MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196		ART UNIT		PAPER NUMBER
		2643		10
DATE MAILED: 03/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/017,957	RAPPS, GARY M.
Examiner	Art Unit	
Sinh Tran	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 December 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. In view of the appeal brief filed on December 17, 2003, PROSECUTION IS HEREBY REOPENED. New ground of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bayer (DE 20009908, published 8/31/00; English translation of DE 20009908 is provided by US 2002/0172386).

Regarding claims 1-5, 7, 9, Bayer discloses a communication device for use behind an ear (BTE, see [0001] and [0042]), comprising a housing (it is inherent that the BTE has a

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housing to house all the electronic circuitries, e.g. microphone, loudspeaker and etc.); a sound delivery tube (28) coupled to the housing (see abstract, lines 1-5); and a self-retaining element (20 of Figs. 1-5; 364 of Figs. 12-15; 460, Fig. 17; 560 of Fig. 20, and Figs. 22-25) rests beneath an inferior crus of the ear and provides positive retention of the device to the ear (stabilization of the sound tube in the region of the entrance to the auditory canal-[0059] and reference 461 refers to a sound tube eye that stabilized a sound tube 428, [0061]) when the sound tube is positioned for non-occluded sound delivery to the ear.

Regarding claims 6, 10-12, Bayer further discloses that the self-retaining element comprises spring properties, flexible or semi-rigid [0045] and is constructed from a material consisting of: rubber, plastic and metal ([0044] and [0054]).

Regarding claim 13, Bayer further discloses that the self-retaining element, when positioned on the ear, applies positive retention across the pinna of the ear between the sulcus and the concha (“part 156 provides the hold, which is shaped to fit into the cyma conchae 50”, [0049] and “its multiple curves, is clearly evident is responsible for the accurate fit and secure seat in the cyma conchae, which prevents it from being moved” [0051]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer in view of Taenzer et al (6,009,183).

Regarding claim 8, Bayer further discloses that the self-retaining element can be formed by injection-molding, [0054]. However, Bayer fails to specifically disclose that the self-retaining element is molded onto the sound delivery tube. Taenzer et al teaches a BTE communication device having an ‘entire sound delivery tube 14, connector 30, and ear tip 16 may be molded together as a single piece from a single material. Alternatively, the connector 30 and ear tip 16 may be connected to the sound delivery tube 14 by over-molding.., col. 5. lines 36-41). Since Bayer only generally disclosed that the self-retaining element is joined to the sound delivery tube and that the self-retaining element can be formed by injection molding, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply any molding technique, including the over molding technique of Taenzer et al to Bayer’s to implement the required joining of the sound tube to the retaining element of Bayer.

Regarding claims 14-15, Bayer fails to teach that the communication device is wireless or wired. However, Taenzer et al teaches a communication device (14) which can be wired (cable 20) or can be implemented as wireless, see col. 2, last paragraph). Therefore, it would have been obvious to one of ordinary skill in the art to apply the teaching of Taenzer et al to Bayer for the purpose of implementing the communication with wire or wireless link.

5. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer in view of Rapps (6,101,259).

Regarding claim 16, Bayer fails to specifically disclose that the BTE housing has a first section that rests on a sulcus of the ear, and wherein the positive retention of the communication device to the ear results from a space between the first section of the housing and the self-retaining element. Rapps teaches a BTE housing having a first section (280, Fig. 1). Since Bayer only generally disclosed the BTE housing, it would have been obvious to one of ordinary skill in the art to use any well known BTE housing structure, including housing structure of Rapps to implement the required BTE housing of Bayer. The first section of the housing along with the self-retaining element of Bayer in view of Rapps would provide positive retention of the communication device to the ear.

Regarding claims 17-18, the combination of Bayer in view of Rapps discloses that the dimension across the space between the first section of the housing and the self-retaining element is .118 inches +/- .054 (firstly, the BTE housing 10 shown by Rapps is incorporated by reference by the present applicant, see page 1 of the present disclosure, therefore, the dimension of the housing is approximately the same. Secondly, the dimension across the space between the first section of the housing and the retaining element would be around .118inches +-.054 since the dimension of the first section of the housing on the ear curving around to near the ear canal would have approximately such dimension for an average ear dimension).

Response to Arguments

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sinh Tran whose telephone number is (703) 305-4040. The examiner can normally be reached on M,T&Th 9:00AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sinh Tran
Primary Examiner
Art Unit 2643

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